

REMARKS

In response to the Notice of Non-Compliant Amendment of August 20, 2004, the Applicant has changed the status identifier of claim 14 to read "currently amended."

In addition, consistent with the Examiner's helpful suggestions, the Applicant has amended claim 14 to restate the claim in terms which eliminate any potential for this apparatus claim to be interpreted as claiming process steps. Because this amendment is made solely for the purpose of clarity to prevent potential misinterpretation, no change in claim scope is intended or to be inferred.

The following remarks are as submitted on April 2, 2004.

Claims 14-35 are currently pending in the present Application.

The Applicant wishes to express his gratitude for the courtesies extended by the Examiner in the Interview conducted on March 26, 2004, as well as the Examiner's allowance of claims 24-32 in the January 5, 2004 Office Action. The following remarks regarding claims 14-23 and 33-35 are consistent with the discussions in the March 26, 2004 Interview.

Claims 14-21, 23 and 33-35 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,885,677 to Gosselin, *et al.* ("Gosselin").¹ Claim

¹ The Applicant notes that Gosselin is not prior art to the present application under § 102(b). Gosselin issued on March 23, 1999, less than one year before the present invention's January 29, 2000 effective U.S. filing date (priority claimed to application PCT/EP00/00724). The Applicant herein responds as if the pending rejection over
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22 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Gosselin in view of European patent document EP 0 845 767 A1 filed by Pennance, *et al.* (“Pennance”).

As discussed in the Interview, the Applicant has amended independent claim 14 to recite that the barrier layer is inscribed and thereby weakened “after the barrier layer has been arranged on the carrier layer.” This amendment is intended to make explicit the novel feature of present invention, wherein the security film is created with an essentially “blank” barrier layer which can later be “written” with a contact-less inscription process, such as with a laser. Accordingly, the “blank” product claimed in claim 14 is uniquely flexible, as it can be inscribed with an infinite variety of characters, logos, etc, at any time before, or even after, its application to an object to be marked.

In marked contrast, Gosselin discloses a security label in which a *pre-configured* barrier mask layer is located between an identifier medium and a substrate to be marked by the medium. Gosselin at 1:56-61; 2:20-37. Once the label applied, the identifier medium diffuses through the gaps in Gosselin’s pre-configured barrier mask to the substrate. *Id.* at 2:45-47. Because the characters or images to be transferred from the Gosselin label to an object are “fixed” at the time of label manufacture (*i.e.*, when its pre-configured barrier mask is applied over the layer containing the identifier medium), Gosselin is inflexible. For

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Gosselin were issued under § 102(e)(2), without waiving or otherwise surrendering the right to subsequently establish prior inventorship under § 102(e)(2) if required.

example, the image to be created on a substrate with a Gosselin label cannot be changed on an as-needed basis in a production environment, such as on an automobile assembly line.

Further, the Gosselin label creates undesired logistics demands, as an inventory of needed images must be maintained, segregated and controlled to minimize the potential for mislabeling objects requiring specific labels. Indeed, the very presence of fixed-format labels increases the likelihood of inadvertent application of an incorrect label to the wrong object. The present invention's "blank" barrier layer, which can be inscribed at an time after it is affixed to its carrier layer, eliminates such logistics concerns. Because all the labels in inventory are "blanks," there is no need for pre-configured label segregation and management. Moreover, the present invention's inscribable barrier layer provides unparalleled flexibility, easily accommodating last-minute events (such as the need to change a serial number during production to accommodate out-of-sequence product manufacture), while significantly reducing the potential for mislabeling errors by allowing inscription in "real-time" in a production environment.²

Because the Gosselin pre-configured label does not disclose or suggest a security film with a barrier layer in which "local variation in the diffusion is

² In the paragraph spanning pages 3-4 of the January 5, 2004 Office Action, it is stated that the "patentability of product does not depend on its method of production." The Applicant notes that while *use* of the claim 14's security film may result in similar *effects* on an object as might result from *use* of the Gosselin label, the "product" recited in claim 14 is not the *result* of a claimed process, but fundamentally different *product* from the (Footnote continued...)

produced by local weakening of the barrier layer after the barrier layer has been arranged on the carrier layer,” the Gosselin reference does not anticipate or otherwise render unpatentable the invention recited in amended independent claim 14 and its dependent claims 15-23. The Applicant further submits that the deficiencies of Gosselin are not cured by its combination with Pennance, which teaches nothing with respect to altering a barrier layer to permit variable diffusion of an identification medium to a substrate. Accordingly, the Applicant respectfully requests the pending §§ 102 and 103 rejections be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing amendments, the Applicants respectfully submit that claims 14-23 and 33-35 are allowable over the cited references. Early and favorable consideration and issuance of a Notice of Allowance for claims 14-35 is respectfully requested.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and

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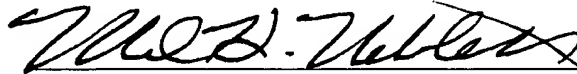
pre-configured Gosselin film, which contains a weaken-able layer that may later be subjected to a process. Thus, a product-by-process rationale is inapplicable here.

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Account No. 05-1323 (Docket #225.50372US).

September 20, 2004

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Donald D. Evenson", written over a horizontal line.

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